

## REMARKS

Applicant has carefully reviewed the Final Office Action mailed September 20, 2006 and offers the following remarks.

Claims 1-3, 5, 6, 11, 14-18, and 27-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,405,362 B1 to Shih et al. (hereinafter "Shih") in view of the article entitled "Taking the Byte Out of Cookies" by Lin et al. (hereinafter "Lin"). To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

First of all, Applicant respectfully requests that the finality of the Office Action be withdrawn. In the Office Action mailed April 7, 2006, the Patent Office rejected claims 1-11, 13-18, and 27-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,128,730 to Levine in view of Shih and further in view of Lin. In the current Office Action, claims 1-3, 5, 6, 11, 14-18, and 27-32 are now rejected in view of Shih and Lin. Levine is not being used in the rejection of these claims. Thus, claims 1-3, 5, 6, 11, 14-18, and 27-32 are being rejected on new grounds. Applicant did not amend these claims. Thus, the new ground of rejection was not necessitated by any amendment. The office action cannot be made final where the Examiner introduces a new ground of rejection which is not necessitated by applicant's amendment. MPEP § 706.07(a). Applicant therefore requests that the finality of the Office Action mailed September 20, 2006, be withdrawn.

Applicant initially submits that the Patent Office has failed to support its stated motivation to combine the references with actual evidence as is required by applicable Federal Circuit case law. Applicant is aware that most inventions are combinations of known elements. One of the things that makes an invention patentable is that there was no suggestion to combine the known elements in the manner claimed. To avoid impermissible hindsight reconstruction, the Federal Circuit, in *Dembiczak*, acknowledged earlier case law that set forth various sources

from which a suggestion to combine references may come, but reiterated that the range of available sources does not diminish the requirement for actual evidence to support the stated motivation to combine. *In re Dembicza*k at 999. In the present application, the Patent Office has not complied with the requirements set forth by the Federal Circuit. Specifically, the Patent Office asserts that the motivation to combine the references is “because the cookie is used to provide the user with a customized service.” (Office Action mailed September 20, 2006, page 4). This asserted motivation lacks the required actual evidence to support it. In addition, the Patent Office has provided no rationale of why a person of ordinary skill in the art reading Shih would be interested in customized service. Therefore, the motivation itself has no rationale to support it. Since the motivation lacks both supporting rationale and the required actual evidence, the motivation is improper. Since the motivation is improper, the combination of references is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

In the Response to Arguments section of the current Office Action, the Patent Office asserts a different motivation to combine the references, namely that the system will reduce the resources needed by cleaning up after removal of the flash card, not requiring a browser, and resources may be accessed without going through a device driver (Office Action mailed September 20, 2006, p. 3). Applicant notes that this was the same motivation as was proffered to support the combination of Shih and Levine in the previous Office Action (see Office Action mailed April 7, 2006, pp. 3-4). Applicant respectfully submits that this asserted motivation does not provide a motivation to combine Shih with Lin, as is being asserted in the present Office Action. Thus, the motivation is improper. Since the motivation is improper, the combination of references is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

In addition, even if the combination is proper, a point Applicant does not concede, the combination of Shih and Lin do not teach or suggest each and every element of the claimed invention. Claim 1 recites that the software on the portable device be adapted to automatically execute on the host computing device in association with a computing session and configure other software running on the host computing device. The flash card of Shih does not contain software that automatically executes on the host computing device in association with a computing session and configures other software running on the host computing device. In Shih,

an event monitor searches the flash card that was inserted into the PC for an auto-run program (Shih, col. 6, lines 56-59). After locating the autorun program, the event monitor runs the program, passing it to a command line indicating that it is to install and/or run the application on the computer readable medium, that is, the application on the flash card is run (Shih, col. 7, lines 19-22 and 52-57). Thus, in Shih, the autorun program installs and runs an application on the flash card. Shih does not configure other software running on the host computing device. Thus, the flash card of Shih does not contain software on the portable device that automatically executes on the host computing device and configures other software running on the host computing device, as required by the claimed invention. Since Shih does not teach or suggest software on the portable device that automatically executes on the host computing device and configures other software running on the host computing device, Shih does not teach or suggest each and every limitation of claim 1. Lin does not cure the deficiencies of Shih. Thus, claim 1 is patentable over the combination of Shih and Lin.

In addition, claim 1 recites software adapted to automatically execute on the host computing device and “instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session, said removed records including one or more of the group consisting of browsing histories, cookies, preferences, favorites, and bookmarks from one or more of the group consisting of system memory, cache, and disk drives” (emphasis added). The proposed combination of Shih and Lin does not teach the above element. The Patent Office asserts that Shih discloses deleting configuration files during the cleanup. The Patent Office admits that Shih does not disclose that the configuration files correspond to the cookies as recited in the claim (Office Action mailed September 20, 2006, p. 4). Instead, the Patent Office asserts that Lin discloses that cookies are a block of text used to create a customized service and therefore a cookie is a block of text used to configure the website, thus somehow making a configuration file corresponding to a cookie. *Id.*

Applicant argued in its previous response that that no person of ordinary skill in the art would consider a configuration file to correspond to a cookie (See Response filed July 5, 2006, pp. 4-5). A cookie is, as defined in the Lin reference, simply a block of text. Indeed, cookies are simple pieces of data unable to perform any operations by themselves (see Wikipedia definition of “HTTP cookie” at [www.en.wikipedia.org/wiki/HTTP\\_cookie](http://www.en.wikipedia.org/wiki/HTTP_cookie)). In contrast, a configuration

file is a file, often written in ASCII, that is used to configure the initial settings for computer programs (see Wikipedia definition of “configuration file” at [www.en.wikipedia.org/wiki/Configuration\\_file](http://www.en.wikipedia.org/wiki/Configuration_file)). Therefore, it is obvious that a cookie is not the same thing as a configuration file.

The Patent Office continues to assert that cookies are used to instruct a server to send a customized version of the requested web page, and that therefore a cookie is used as a configuration file (Office Action mailed September 20, 2006, Response to Arguments, p. 2). However, the Patent Office provides no support for this line of reasoning. Lin does not state that a cookie is used to instruct a server to send a customized version of the requested web page. Nor does it state that a cookie is used as a configuration file. The Patent Office also does not cite to any definition of cookie to support such an improper interpretation. Lin does disclose that cookies can be used to create a customized service. However, a teaching that a customized service can be created is not equivalent to a cookie being used to configure the browser. A reading of the entire section 8.1 of Lin shows clearly that Lin does not teach that the cookie is used to configure the browser. In fact, a cookie does not configure the browser. The Examiner points to nothing in Lin or elsewhere that would support a statement that a cookie configures a browser.

The Patent Office also states that the definition of configuration is “to establish the user’s preferences and therefore for customizing.” (Office Action mailed September 20, 2006, Response to Arguments, p. 2). Once again, the Patent Office provides no support for such an interpretation. The definition of “configuration file” provided above shows that a configuration file is a file, often written in ASCII, that is used to configure the initial settings for computer programs. This definition is contrary to that asserted by the Patent Office. Until the Patent Office provides support for its definition of configuration, Applicant submits that it is improperly using an unreasonable interpretation of the claim language. As such, under a reasonable interpretation of the claim language, a cookie does not configure a browser, and therefore, a cookie is not a configuration file. Thus, the deleting of a configuration file as allegedly taught in Shih in light of Lin is not the same as removing the browsing histories, cookies, preferences, and bookmarks as recited in the claim.

As such, the references individually do not teach or suggest the claim element. Since the references individually do not teach or suggest the claim element, the combination of references

cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness and claim 1 is allowable.

Claims 14 and 27 contain similar limitations as claim 1 and are patentable for the same reasons. Claims 2, 3, 5, 6, 11, 15-18, and 28-32 depend from one of the above independent claims and are thus also patentable for the same reasons.

Claims 7-10, 13, and 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shih in view of Lin as applied to claims 1 and 27, and further in view of U.S. Patent No. 6,128,730 to Levine (hereinafter “Levine”). Applicant respectfully traverses. The standards for obviousness are set forth above.

Applicant initially submits that the Patent Office has failed to support its stated motivation to combine the references with actual evidence as is required by applicable Federal Circuit case law. To avoid impermissible hindsight reconstruction, the Federal Circuit, in *Dembiczak*, acknowledged earlier case law that set forth various sources from which a suggestion to combine references may come, but reiterated that the range of available sources does not diminish the requirement for actual evidence to support the stated motivation to combine. *In re Dembiczak* at 999. In the present application, the Patent Office has not complied with the requirements set forth by the Federal Circuit. Specifically, the Patent Office asserts that the motivation to combine Levine with Shih and Lin is “because authentication decreases fraud.” (Office Action mailed September 20, 2006, page 8). This asserted motivation lacks the required actual evidence to support it. Instead, the Patent Office has provided only a conclusory statement without any support. This is exactly the sort of statement found insufficient by the Federal Circuit in *Dembiczak*. Since the motivation lacks the required actual evidence to support it, the motivation is improper. Since the motivation is improper, the combination of references is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

In addition, claim 7-10, 13, and 30-32 depend from claims 1 or 27 and are patentable for the same reasons set forth above with respect to claim 1.

Claims 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shih in view of Lin as applied to claim 1 and further in view of the Scan Tech News Article. Applicant respectfully traverses. The standards for obviousness are set forth above.

As explained above, the combination of Shih and Lin does not show each and every element. In particular, the combination of Shih and Lin does not teach or suggest software on the portable device that automatically executes on the host computing device and configures other software running on the host computing device, as required by the claimed invention. Nor does the combination of Shih and Lin teach or suggest the element regarding removing records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session, said removed records including one or more of the group consisting of browsing histories, cookies, preferences, favorites, and bookmarks from one or more of the group consisting of system memory, cache, and disk drives. The addition of the Scan Tech News article does not cure the deficiencies of the original combination. Thus, the combination of references does not teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness, and claim 12 is allowable.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,  
WITHROW & TERRANOVA, P.L.L.C.

By:



John R. Witcher, III  
Registration No. 39,877  
P.O. Box 1287  
Cary, NC 27512  
Telephone: (919) 654-4520

Date: November 20, 2006  
Attorney Docket: 4989-008